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EXAMINER
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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE <u>3</u> MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.
- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1) ☒ Responsive to communication(s) filed on <u>02 April 2010</u>.

2a) ☒ This action is **FINAL**.   2b) ☐ This action is non-final.

3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4) ☒ Claim(s) <u>1-5,12-16,23-25 and 31-33</u> is/are pending in the application.

    4a) Of the above claim(s) <u>6-11, 17-22 and 26-30</u> is/are withdrawn from consideration.

5) ☐ Claim(s) _____ is/are allowed.

6) ☒ Claim(s) <u>1-5,12-16,23-25 and 31-33</u> is/are rejected.

7) ☐ Claim(s) _____ is/are objected to.

8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9) ☐ The specification is objected to by the Examiner.

10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.

    Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

    Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

    a) ☐ All   b) ☐ Some * c) ☐ None of:

      1. ☐ Certified copies of the priority documents have been received.

      2. ☐ Certified copies of the priority documents have been received in Application No. _____.

      3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

    * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)

2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)

3) ☐ Information Disclosure Statement(s) (PTO/SB/08)
    Paper No(s)/Mail Date _____.

4) ☐ Interview Summary (PTO-413)
    Paper No(s)/Mail Date. _____.

5) ☐ Notice of Informal Patent Application

6) ☐ Other: _____.

DETAILED ACTION

- Claims 1-5, 12-16, 23-25 and 31-33 are pending; claims 6-11 and 17-22 is

  withdrawn; claims 26-30 are canceled; claims 31-33 are added.

Response to Amendment/Argument

1.   Applicant's amendments filed 2 April 2010 have been fully considered.

2.   The objection to the abstract is withdrawn because the abstract was amended to

having words between 50 and 150.

3.   The rejection to claims 1-5 and 12-16 under 35 U.S.C. § 101 cannot be

withdrawn even though the claims were amended.

        a.   Regarding claims 1-5, it seems like the applicant added the limitation,

"where in the captured user input data is to be stored in a memory" to overcome the

rejection. However, the limitation is only extra post activity solution. So, the rejection

cannot be withdrawn.

        b.   Regarding claim 12-16, the claims are still directed to an article, which is a

non-statutory subject matter. So, the rejection cannot be withdrawn.

4.   Applicant's argument of rejection to 35 U.S.C. 102(b), with respect to claims 1-4,

12-15 and 23-25, has been considered but are moot in view of the new ground(s) of

rejection.

5.   Applicant's argument of rejection to 35 U.S.C. 103(a), with respect to claims 5

and 16, has been considered but are moot in view of the new ground(s) of rejection.

Claim Rejections - 35 USC § 101

6.   35 U.S.C. 101 reads as follows:

> Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

7.   Claims 1-5 are rejected under 35 U.S.C. 101 as not falling within one of the four statutory categories of invention.   Supreme Court precedent[1] and recent Federal Circuit decisions[2] indicate that a statutory "process" under 35 U.S.C. 101 must (1) be tied to another statutory category (such as a particular apparatus), or (2) transform underlying subject matter (such as an article or material) to a different state or thing. While the instant claim(s) recite a series of steps or acts to be performed, the claim(s) neither transform underlying subject matter nor positively tie to another statutory category that accomplishes the claimed method steps, and therefore do not qualify as a statutory process.

8.   Claims 12-16 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter as follows. Claims 12-16 define an article embodying functional descriptive material (i.e., a computer program or computer executable code). However, the claim does not define a "computer-readable medium or computer-readable memory" and is thus non-statutory for that reason (i.e., "When functional descriptive material is recorded on some computer-readable medium it becomes structurally and functionally interrelated to the medium and will be statutory in

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[1] *Diamond v. Diehr*, 450 U.S. 175, 184 (1981); *Parker v. Flook*, 437 U.S. 584, 588 n.9 (1978); *Gottschalk v. Benson*, 409 U.S. 63, 70 (1972); *Cochrane v. Deener*, 94 U.S. 780, 787-88 (1876).
[2] *In re Bilski*, 88 USPQ2d 1385 (Fed. Cir. 2008).

most cases since use of technology permits the function of the descriptive material to be

realized" – Guidelines Annex IV). The scope of the presently claimed invention

encompasses products that are not necessarily computer readable, and thus NOT able

to impart any functionality of the recited program. The examiner suggests amending the

claim(s) to embody the program on "computer-readable medium" or equivalent;

assuming the specification does NOT define the computer readable medium as a

"signal", "carrier wave", or "transmission medium" which are deemed non-statutory

(refer to "note" below). Any amendment to the claim should be commensurate with its

corresponding disclosure.

Claim Rejections - 35 USC § 112

9.   Claims 31-33 are rejected under 35 U.S.C. 112, first paragraph, as failing to

comply with the written description requirement. The claim(s) contains subject matter

which was not described in the specification in such a way as to reasonably convey to

one skilled in the relevant art that the inventor(s), at the time the application was filed,

had possession of the claimed invention. In page 4, lines 19-21 of the specification, it is

disclosed that "the application program during recording and playback **may be** executed

on different computer systems," which the scope is different with claims 31-33

[emphasis added]. "Is to be" and "may be" makes the scope different.

Claim Rejections - 35 USC § 102

10.   The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that

form the basis for the rejections under this section made in this Office action:

> A person shall be entitled to a patent unless –
>
> (a) the invention was known or used by others in this country, or patented or described in a printed publication in this or a foreign country, before the invention thereof by the applicant for a patent.

11.   Claims 1-4, 12-15 and 23-25 are rejected under 35 U.S.C. 102(a) as being

anticipated by Redstone Software, Inc. ("Software Automation & Testing", hereinafter,

"Redstone").

Regarding claim 1, Redstone discloses a method of automatically controlling

execution of an application program having a graphical user interface (page 2,

"Eggplant") comprising: capturing user input data and images (page 7, "capture mode";

page 8, "capture images of the target controls and screen locations") displayed by the

graphical user interface (page 8, figure) during a recording phase of execution of the

application program; analyzing the captured user input data and displayed images to

generate an execution scenario script during the recording phase (pages 8 and 12,

"generating a script"), wherein the captured user input data is to be stored in a memory

("The invention is a software, which makes it readily apparent that a computer having a

memory is required to run it."); generating simulated user input data based on the

execution scenario during a playback phase of execution of the application program and

inputting the simulated user input data to the application program (page 4, "Scripts

interact with the system-under-test at the same level that a real user would, keying off

the same visual cues and sending the same inputs"); performing image analysis on

images displayed by the graphical user interface as a result of processing the simulated

user input data during the playback phase and captured displayed images from the

recording phase (page 4, "Scripted actions use advanced image-matching algorithms to

locate elements of the interface to target"); and automatically controlling execution of

the application program based at least in part on the image analysis (page 4, "Scripted

actions use advanced image-matching algorithms to locate elements of the interface to

target").

Regarding claim 2, Redstone discloses wherein performing image analysis

comprising comparing the displayed images captured during the recording phase with

displayed images from the playback phase (page 4, "advanced image-matching

algorithm").

Regarding claim 3, Redstone discloses wherein the user input data comprising at

least one of keyboard input data and mouse input data (page 16, "driven by the mouse

or the keyboard").

Regarding claim 4, Redstone discloses wherein analyzing the captured user

input data and displayed images in the recording phase comprising identifying actions of

the application program corresponding to the captured user input data (Page 7, "For the

user to interact remotely with system using script, it is readily apparent and inherent that

the analyzing process will identify actions of the application program corresponding to

the captured user input data.").

Regarding claims 12-15, claims 12-15 are analogous and correspond to claim 1-

4, respectively. See rejection of claims 1-4 for further explanation.

Regarding claims 23-25, claims 23-25 are analogous and correspond to claim 1-

2 and 4, respectively. See rejection of claims 1-2 and 4 for further explanation.

Claim Rejections - 35 USC § 103

12.   The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all

obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set
> forth in section 102 of this title, if the differences between the subject matter sought to be patented and
> the prior art are such that the subject matter as a whole would have been obvious at the time the
> invention was made to a person having ordinary skill in the art to which said subject matter pertains.
> Patentability shall not be negatived by the manner in which the invention was made.

13.   Claims 5, 16 and 31-32 are rejected under 35 U.S.C. 103(a) as being

unpatentable over Redstone Software, Inc. ("Software Automation & Testing",

hereinafter, "Redstone").

Regarding claim 5, Redstone discloses using a script, but not any details which

markup language is used. However, the applicant does not disclose any advantage or

reason why XML is used as the markup language for the script. Especially, the applicant

only discloses that XML can be used as one of the high level language for the script in

the abstract. So, using a XML for the script will be a design choice.

It would have obvious in one of the ordinary skill in the art to use XML as a

markup language for the script of the Redstone's invention because XML is one of the

widely used markup language and will provide simplicity, generality, and usability for

applications.

Regarding claim 16, claim 16 is analogous and corresponds to claim 5. See
rejection of claim 5 for further explanation.

Regarding claim 31, Redstone discloses all the previous claim limitations.
Redstone does not explicitly disclose the claim limitation specified in claim 31. However,
it is well-known that different computers can be use for different steps or processing.

It would have obvious in one of the ordinary skill in the art to use different
computers for the recording process and playback phase of Redstone to make the
computing processing faster and efficient by decreasing the deadlocks.

Regarding claims 32-33, claims 32-33 are analogous and correspond to claim
31. See rejection of claim 31 for further explanation.

Conclusion

14.   **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time
policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE
MONTHS from the mailing date of this action. In the event a first reply is filed within
TWO MONTHS of the mailing date of this final action and the advisory action is not
mailed until after the end of the THREE-MONTH shortened statutory period, then the
shortened statutory period will expire on the date the advisory action is mailed, and any
extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of
the advisory action. In no event, however, will the statutory period for reply expire later
than SIX MONTHS from the mailing date of this final action.

15.   Any inquiry concerning this communication or earlier communications from the examiner should be directed to JOHN Wahnkyo LEE whose telephone number is (571)272-9554. The examiner can normally be reached on Monday - Friday (Alt.) 7:30 a.m. - 5:00 p.m..

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Samir Ahmed can be reached on (571) 272-7413. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/John Wahnkyo Lee/
Examiner, Art Unit 2624

/Samir A. Ahmed/
Supervisory Patent Examiner, Art Unit 2624